

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: A. Maxwell Eliscu
Title: SYSTEM FOR AND METHOD OF HANDLING
REFERRALS FROM REFERRING PARTIES
Appl. No.: 09/667,391
Filing Date: 9/20/2000
Examiner: Jennifer L. Liversedge
Art Unit: 3684
Confirmation Number: 6064

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) as determined by the USPTO in the Notice of Allowance dated October 22, 2009, for the above-referenced application. The USPTO determined that the patent was entitled to 1,436 days of PTA.

In performing its calculations, the PTO correctly granted 784 days of PTA accumulated on behalf of the applicant under 37 C.F.R. §§ 1.702(a)(1) & 1.703(a)(1) and, 567 days under 37 C.F.R. §§ 1.702 (e) & 1.703(b)(4). However, the PTO deducted 182 days of PTA by erroneously applying 37 C.F.R. § 1.704(b) on the basis of events related to the notice of abandonment issued in this case for applicant's alleged failure to respond to the January 13, 2004 office action.

The notice of abandonment was subsequently rescinded, and the PTO acknowledged its receipt of the applicant's timely response to the January 13, 2004 office action, as filed on April 14, 2004. However, instead of calculating PTA in applicant's favor as of the date of the PTO's actual receipt of the applicant's response, *i.e.*, April 14, 2004, the PTO used the filing date of the

applicant's petition to revive, *i.e.*, October 12, 2004, to perform PTA calculations under 37 C.F.R. §§ 1.702(a)(2) & 1.703(a)(2), which resulted in 418 days of PTA in applicant's favor, instead of 600 days, calculated from April 14, 2004, up through April 6, 2006, the mailing date of the final office action.

Finally, the PTO also failed to grant applicant an additional 518 days of non-overlapping PTA days. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On January 7, 2010, the U.S. Court of Appeals for the Federal Circuit affirmed the September 30, 2008, decision of the United States District Court for the District of Columbia finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Kappos*, No. 2009-1120 (Jan. 7, 2010). The Federal Circuit determined that "[b]efore the three-year mark, no 'overlap' can transpire between the A delay and the B delay," and that "[i]f an A delay occurs on one day and a B delay occurs on a different day, those two days do not 'overlap' under section 154 (b)(2)."

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 2,136 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	2,288 days
(b) Total Applicant delay:	152 days
Final PTA Determination:	2,136 days

Applicants therefore respectfully request that the patent be accorded 2,136 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or

absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Respectfully submitted,


Date: January 15, 2010

FOLEY & LARDNER LLP

Customer Number: 23524

Telephone: (608) 258-4263

Facsimile: (608) 258-4258

By: _____

Callie M. Bell

Attorney for Applicant

Registration No. 54,989

Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 046983-0103

Application Number: 09/667391

Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	09/20/2000	0		
CLOSE WINDOW	14 Add/Change Application Case	11/20/2001	426		
	3 Year Period Starts	09/20/2003	1,095		
Edit Delete	Non-Final Office Action	01/13/2004	1,210	(784)	
	Non-Final Office Action + 3 months	04/13/2004	1,301		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	04/14/2004	1,302		1
	Non-Final Office Action Rsp. Rcv'd at PTO + 4 mo	08/14/2004	1,424		
Edit Delete	Final Office Action	04/06/2006	2,024	(600)	
Edit Delete	Final Office Action Response Received at PTO	06/09/2006	2,088		
Edit Delete	Advisory Action	06/21/2006	2,100		
	Final Office Action + 3 months	07/06/2006	2,115		
Edit Delete	Request For Continued Examination (including amendment)	08/07/2006	2,147	(1052) 1721	32
	3 Year Period Stopped	08/07/2006	2,147		
Edit Delete	Non-Final Office Action	10/18/2006	2,219		
	Non-Final Office Action + 3 months	01/18/2007	2,311		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	02/13/2007	2,337		26
Edit Delete	Non-Final Office Action	04/05/2007	2,388		
	Non-Final Office Action + 3 months	07/05/2007	2,479		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	07/12/2007	2,486		7
Edit Delete	Final Office Action	09/11/2007	2,547		
	Final Office Action + 3 months	12/11/2007	2,638		
Edit Delete	Notice of Appeal Received at PTO	03/06/2008	2,724		86
Edit Delete	Pre-Appeal Brief Request Received at PTO	03/06/2008	2,724		
Edit Delete	Appeal Brief Received at PTO	05/06/2008	2,785		
Edit Delete	Examiner's Answer Mailed	05/22/2008	2,801		
Edit Delete	Appeal Decided by Appeal Board; Some Rejections Reversed	09/23/2009	3,290	567	
Edit Delete	Notice of Allowance	10/22/2009	3,319		
	Projected Patent Grant Date	05/04/2010	3,513		

Totals:	2,288	152
PTA:	2,136	



Version: 3.02.05 LOGIN Victoria Downing IP 10.24.5.12 Foley & Lardner LLP